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OFFICE OF PETITIONS

In re Application of
Michael A. Ekhaus et al
Application No. 09/887,528
Filed: June 25, 2001
Attorney Docket No. 7744.0061

:DECISION DISMISSING PETITION
:UNDER 37 CFR 1.47(a) AS
:INAPPROPRIATE AND NOTICE TO
:FILE MISSING PARTS OF NON-
:PROVISIONAL APPLICATION

This is a decision on the petition under 37 CFR 1.47(a), filed March 18, 2002.

The petition is dismissed as inappropriate.

The instant application was filed on June 25, 2001, without an executed oath or declaration and filing fees. Accordingly, on August 16, 2001, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application requiring the submission of an executed oath or declaration, filing fees, and a \$130 surcharge fee for their late submission.

In reply, petitioner (Mr. James J. Boyle), on March 18, 2002, submitted an executed oath or declaration, the filing and surcharge fees, a petition and fee for a five month extension of time, and the instant petition under 37 CFR 1.47(a) to accept a properly executed declaration by joint inventor Michael A. Ekhaus.

Petitioner states that "[a]lthough Mr. Ekhaus was presented with a copy of the above-identified application, including a copy of the figures, and was presented with a copy of a Declaration for the above-identified application, Mr. Ekhaus has refused to join in the application by refusing to execute the Declaration in a form that would comply with 35 U.S.C. § 115 and 37 C.F.R. § 1.63(b)(2)." More specifically, petitioner states that he received a modified version of an executed declaration by joint inventor Ekhaus, which version was not in compliance with the statute and the rules in that the declaration did not include the language stating that Mr. Ekhaus has "reviewed and understands the contents" of the application. In this regard, joint inventor Ekhaus refuses to execute a declaration in compliance with the statute and the rules because Mr. Ekhaus "firmly believes that he may not be the 'first, original inventor' of anything contained within the application, and because Mr. Ekhaus has not had the opportunity to fully review the application to the decree [sic] that makes him comfortable with

what is contained therein" and was only willing to sign the declaration recently proposed for signature. Therefore, despite numerous efforts to obtain a properly executed declaration from joint inventor Ekhaus, petitioner states that joint inventor Ekhaus refuses to execute a declaration complying with the statute and the rules.

A petition under 37 CFR 1.47(a) is inapplicable to the instant case since Mr. Ekhaus has signed a declaration, albeit not complying with the statute and the rules. However, since the declaration executed by Mr. Ekhaus fails to comply with 35 U.S.C. § 115 and 37 CFR 1.63(b)(2), the declaration is not acceptable. Accordingly, the reply to the Notice of August 16, 2001 is considered to be incomplete.

Therefore, since the reply submitted was a *bona fide* effort to supply a complete reply to the Notice of August 16, 2001, and in order to allow joint inventor Ekhaus sufficient time to review the application papers and provide a properly executed declaration, this decision acts as a Supplemental Notice to File Missing Parts of Nonprovisional Application. Accordingly, a period of two months is set within which to supply a properly executed declaration by joint inventor Ekhaus. This period is extendable pursuant to the provisions of 37 CFR 1.136(a). Failure to file a proper reply will result in the abandonment of this application.

Should Mr. Ekhaus, notwithstanding the extra time that has now elapsed (some 6 additional months) for him to review and understand the instant application papers still decline to execute a declaration in compliance with the statutes and regulations, then the circumstances surrounding any continued refusal to properly "join" in this application should be recounted, and petitioner may then obtain relief under the provisions of 37 CFR 1.47 and 35 U.S.C. § 116. The consequences of acceptance of this application under that regulation and statute as to any nonsigning inventor, as recounted in MPEP 409.03(i) and (j), should be made clear to Mr. Ekhaus.

This application is being forwarded to the Office of Initial Patent Examination to await a reply to the Supplemental Notice to File Missing Parts incorporated in this decision.



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